

Appl. No.: 09/608,311
Amdt. Dated: 05/21/2004
Off. Act. Dated: 05/04/2004

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the discussion presented herein.

1. **Claims Pending.**

The Applicant notes that the Examiner has erroneously indicated that only Claims 7-53 are pending in this case. The status of the claims prior to this response is as follows: Claims 1-53 are pending; Claims 7-21 are withdrawn; Claims 22-53 are subject to restriction and/or election requirement. Correction is respectfully requested.

2. **Election/Restrictions.**

This is the third (3rd) election restriction requirement imposed by the Examiner; only one (1) generic claim has been added to the application since the first election/restriction requirement. The first such requirement was mailed on 11/29/2001, the second such requirement was mailed on 11/21/2002. An examination on the merits was mailed on 06/18/2003. The Applicant believes that the following response will advance prosecution to allowance.

In response to the current election/restriction requirement, the Applicant elects Species A, subspecies A1, and sub-subspecies A1a. This election is made with traverse.

Claim 53 is generic and reads on all species, subspecies, and sub-subspecies, including those not elected herein.

Claims 22, 23, 24, 25, 26, 27, 28, 36, 37, 38, 39, 40, 41, 42, and 44 are generic and read on all species, subspecies, and sub-subspecies, including those not elected herein.

Claims 29, 30, 43, 46, 49, and 50 also read on the elected species, subspecies and sub-subspecies.

Claims 31, 32, 33, 34, 35, 45, 47, 48, 51 and 52 are withdrawn.

Accordingly, based on the foregoing election, the Applicant respectfully submits that Claims 22-30, 36-44, 46, 49, 50 and 53 read on the elected species, subspecies,

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and sub-species, and should be examined herein.

The Applicant traverses the election/restriction requirement for the reason that one or more generic claims are allowable.

In the prior Office Action, generic Claim 22 was rejected under 35 U.S.C. § 102(b) as being anticipated by Wei et al. "Scanning Tip Microwave Near-field Microscope" by Wei et al. published on June 10, 1996. However, that reference was removed as prior art because (i) the cited reference did not publish more than one-year prior to the effective filing date of this application, and (ii) the subject matter claimed in the instant application and the subject matter of the Wei et al. reference were commonly owned at the time later invention was made. Therefore, for the reasons set forth in Applicant's prior response, the rejection should be withdrawn.

In the prior Office Action, generic Claim 22 was also rejected as being anticipated by Yalin et al. (actually should be Lu et al.) "Nondestructive Imaging of Dielectric-Constant Profiles and Ferroelectric Domains with a Scanning-Tip Microwave Near-Field Microscope" published June 27, 1997. However, the subject reference was published after the effective filing date of the instant application and is not prior art as against Claim 22. Therefore, for the reasons set forth in Applicant's prior response, the rejection should be withdrawn.

Additionally, in the prior Office Action, generic Claims 22 and 53 (the two pending independent claims) were rejected as being anticipated by Xiang et. al. (US Patent No. 5,821,410). However, the instant application is a continuation-in-part of the cited reference and is entitled to the priority date thereof. Furthermore, Claims 22 and 53 are fully supported the cited reference, and Xiao-Dong Xiang is the sole inventor of the subject matter of those claims as established by the Rule 132 Declaration that was filed. Therefore, Xiang et al. is not prior art under 35 U.S.C. §102(e) since this application claims priority to Xiang et al. The Examiner acknowledged that the rejection was withdrawn in the instant Office Action.

Therefore, since one or more generic claims are allowable over the cited art of

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record, the election/restriction requirement is improper and Applicant is entitled to allowance of all species that depend from the generic claims under 37 CFR 1.141.

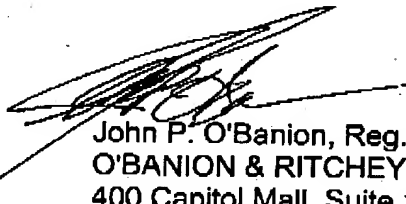
3. Conclusion.

In view of the above, the election/restriction requirement is improper and Claims 22-53 are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

The Applicant also respectfully requests a telephone interview with the Examiner in the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims.

Date: 5/21/04

Respectfully submitted,



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